

REMARKS

Formal Matters

Claims 58-83 are pending after entry of the amendments set forth herein.

Claims 58-80 and 82 are withdrawn.

Applicants respectfully request reconsideration of claims 81 and 83 in view of the remarks made herein.

Restriction requirement/species election

The Office requires an election of one claim group. As set forth in the Office Action, the groups are:

- I. Claims 58, 60-76 and 79, drawn to a method of screening a plurality of cells comprising introducing a plurality of a library of nucleic acids.
- II. Claims 59, 77 and 78, drawn to a method of screening using a bioactive agent precursor.
- III. Claims 80, 60-76 and 79, drawn to a method of screening with a retroviral vector.
- IV. Claims 81-83, drawn to a method of screening an enzymatic complex.
- V. Claim 82, drawn to a method of screening an enzymatic complex with a bioactive agent.

Further, the Office requires election of a species, chosen from the following, for initial examination:

A) Species for scaffold fusion partners:

1. Targeting sequence
2. Rescue sequence
3. Stability sequence

B) Species of enzyme fusion partners:

1. Targeting sequence
2. Rescue sequence

3. Stability sequence

The Applicants elect **Group IV** claims with traverse.

The Applicants elect **Targeting species** as species of scaffold *and* enzyme for initial examination.

The Applicants respectfully traverse the Restriction Requirement. The reasons for traverse are set forth below.

The Applicants respectfully traverse the restriction requirement on the basis that the subject matter of several of the claim groups ***is completely encompassed by*** other claim groups. For example, the claims of Group V and II are completely encompassed by the claims of Groups IV and I, respectively. The Office argues that “the search required for Group I is not required for Groups II-V”. However, the Applicants respectfully submit that it would require no extra effort on the behalf of the Office to search the subject matter of Groups I and II, or Groups IV and V, since the subject matter of Groups II and V is completely encompassed by Groups I and IV, respectively. Group III claims, for example, are nearly identical to those of Group I or IV, and merely recite a “retroviral vector” instead of a vector. Is this what the Examiner intends?

Further, all the pending claims are all directed *methods of screening using cells containing a library of exogenous scaffolds*. The Office argues that the inventions “have acquired a separate status in the art because of their recognized divergent subject matter”. However, the Office has provided no evidence to support this position, and, as such, is merely reciting the Examiner’s opinion. In contrast to the Examiner’s opinion, the Applicants respectfully submit these methods, whether or not they are done using precursor agents or retroviral vectors, etc., fall into a single class and digest, class 435, digest 5 “COMBINATORIAL CHEMISTRY AND LIBRARY TECHNOLOGY...Method of screening a library...Involving a biologically replicable entity (e.g., genetic package, vector, etc.) which is the library, displays the library, contains the library or presents the library...The entity is a microorganism, animal cell or plant cell” according to the U.S. Patent and Trademark Office’s own patent classification system. The Patent Office classification system does not separately classify methods of screening using libraries of cells into those that contain precursor agents or retroviral vectors. Accordingly, the

Applicants respectfully submit that there is no basis for this restriction requirement.

In view of the foregoing, it is respectfully request that the restriction requirement be withdrawn.

The Examiner is reminded that upon election of a species for initial examination, the Examiner's actions must conform to MPEP §809.02(c). If the generic claim, in this case claim 81, is allowable, the election of species must be withdrawn.

Applicants expressly reserve the right under 35 USC §121 to file a divisional application directed to the non-elected subject matter during the pendency of this application.



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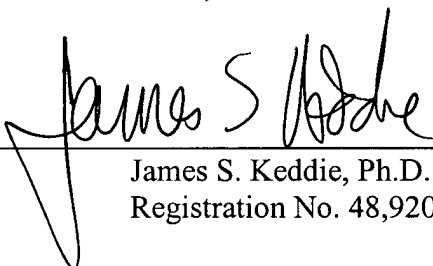
CONCLUSION

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number RIGL-014.

Respectfully submitted,
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Date: November 7, 2003

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